

REMARKS

Claims 1-29 are pending in the present application. In the Office Action mailed October 4, 2003, the Examiner withdrew claims 11-29 from consideration. The Examiner rejected claims 2 and 4 under 35 U.S.C. 112, second paragraph, as being indefinite. Next, the Examiner rejected claims 1-10 under 35 U.S.C. §103(a) as being unpatentable over Wallace et al. (USP 6,564,121).

Finality of Election/Restriction

Applicant believes the Restriction Requirement of July 28, 2003, was traversed in the Election and Traversal of August 22, 2003. However, the Examiner now made the requirement Final and withdrew claims 11-29 from consideration. As Applicant believes the restriction to be improper and unsustainable, Applicant files concurrently herewith a Petition under 37 C.F.R. §1.144 requesting review of the restriction requirement.

Rejections under §112

Regarding the rejection of claims 2 and 4, Applicant has amended the claims to define PRD and OTR as Phase Review Discipline and Order Through Remittance, respectively. As such, Applicant believes the rejection of claims 2 and 4 under §112 is traversed.

Rejections under §103(a)

The Examiner rejected each and every claim as being unpatentable over a single reference: Wallace et al. More specifically, the Examiner provided a single paragraph whereby the Examiner summarily concluded that the claimed invention was obvious in light of the teachings of Wallace et al. However, rather than provide clear and convincing reasoning as to why the Examiner believed each and every element of the claimed invention was obvious in light of Wallace et al., the Examiner simply stated that "Wallace discloses an electronic transaction system for medical products from cabinets 20 over a global communication network, e.g. claim 29." The Examiner did not provide any reasoning as to how this single statement regarding Wallace et al. renders the claimed invention obvious. The Examiner did not cite a single column or section of Wallace et al. as teaching the claimed invention even though Wallace et al. is a 98 page reference. In short, the Examiner has not made the required *prima facie* case of obviousness, and for this reason alone, the rejection is not proper and not sustainable.

Substantially, Wallace et al. is directed to "systems and methods for drug dispensing." Title of Wallace et al. That is, Wallace teaches a system for "safe pharmaceutical prescription dispensing directly by physicians, pharmacists, and other trained or licensed practitioners operating in small to medium size locations in a cost-effective manner." Col. 6, Ins. 12-15,

emphasis added. Wallace et al. teaches a specific system to effectuate safe delivery of pharmaceuticals. On the other hand, the claimed invention is “a method of designing an electronic transaction system.” Title, emphasis added. Therefore, while Wallace et al. teaches a system for delivering pharmaceuticals, the claimed invention is directed to designing an electronic transaction system. It appears that Examiner has confused a method for designing an electronic transaction system with an implementation of an electronic system. However, one of ordinary skill in the art will recognize that a method for designing an end-product is not the same as the end-product itself. This clear distinction is further evidenced by the elements of the claims.

Regarding claim 1, the claim, in part, calls for a method for designing an electronic transaction system including “reviewing existing direct sales screening processes to ensure current policy compliance, creating new screening processes to minimize commercial risk in an electronic transaction, integrating the existing direct sales screening processes and new screening processes and determining and implementing legal terms and conditions for the electronic transactions.” The claim then calls for “forming electronic media for the steps of reviewing, creating, integrating, determining, and posting the electronic media on a global communications network.” Therefore, claim 1 calls for specific steps of (1) reviewing, (2) creating, (3) integrating, (4) determining, (5) forming, and (6) posting.” However, Wallace et al. fails to teach any of these very specific steps, let alone the combination of each step, as claimed.

Claim 2 then adds to the particular steps called for in claim 1 by further calling for “reducing end user risks by reducing transaction variation and by establishing a global registration process, setting electronic commerce guidelines for site design managers, determining status of contractual jurisdictional compliance, developing region specific legal checklists and training to ensure compliance, developing regional resource reference pools using e-mail, public folders, and other electronic tools to disseminate information, designing add-on modules to ensure an enhanced end user experience, drafting agreements with exclusions to exclusive relationships, integrating with Phase Review Discipline (PRD) systems, tracking all new electronic commerce generated offers, and tracking product/service offerings online through customer surveys.” Therefore, claim 2 specifically calls for (1) reducing, (2) setting, (3) determining, (4) developing, (5) developing, (6) designing, (7) drafting, (8) integrating, and (10) & (11) two steps of tracking.” However, the Examiner failed to address any of these 11 specific elements for designing called for in claim 2 or the 17 elements for designing called for by the combination of claims 1 and 2.

Similar distinctions can be made for claims 3-10 whereby each claim adds particular elements or steps for designing an electronic transaction system, none of which is taught or suggested by Wallace et al. However, Applicant will not specifically address each claim, primarily because the Examiner did not do so and has therefore not met the burden of proof of obviousness.

The Examiner took Official Notice of a plethora of elements not taught or suggested by Wallace et al. yet have been affirmatively claimed in the present application. Specifically, the Examiner took Official Notice that “it is common knowledge that medical products/devices are governed by various state/federal/international laws/regulations/screening processes and compliance with these laws/regulations/screening processes is to minimize commercial risk via contractual obligation is required if the product is to be marketed via direct sales.” The Examiner then concluded that “[t]he tracking of sales is common knowledge in the product sales art.” Then without any support whatsoever, the Examiner asserted as fact that “[t]o have provided the Wallace system to comply with the various state/federal/international laws/regulations/screening processes to minimize commercial risk would have been obvious to one of ordinary skill in the art.”

The Examiner’s application of Official Notice is inappropriate under the MPEP and Applicant hereby objects to such an application. “The Examiner may take Official Notice of facts outside of the record which are capable of instant and unquestionable demonstration as being ‘well-known’ in the art.” MPEP §2144.03. That is, “any facts so noticed should be of notorious character and serve only to ‘fill in the gaps’ in an insubstantial manner which might exist in the evidentiary showing made by the Examiner to support a particular ground for rejection.” MPEP §2144.03. Additionally, MPEP §2144.03 is clear that “such rejections [relying on Official Notice] should be judiciously applied,” be “rare,” and be used “[i]n limited circumstances.” Applicant does not believe that the Examiner’s use of Official Notice is merely to “fill in the gaps.” That is, the Examiner took Official Notice of multiple elements of multiple claims, thereby effectively attempting to fill large “holes” in the rejection rather than mere “gaps.” In essence, the Examiner’s rejection is akin to “I know its out there, but I can’t prove it.” Such is not sufficient to sustain an obviousness rejection. Applicant objects to the use of Official Notice, and respectfully requests valid prior art to validate any future rejections, including the present obviousness rejection.

Specifically, the Examiner took Official Notice that (1) medical products are governed by state/federal/international laws/regulations/screening processes and (2) compliance with these

laws/regulations/screening processes is to minimize commercial risk via contractual obligation is required if the product is to be marketed via direct sales. Therefore, the Examiner took Official Notice as to at least two elements. As such, it is readily apparent that the Examiner's use of Official Notice is far from "rare." Additionally, it is clear that Official Notice has not herein been "judiciously applied" to merely "fill in the gaps." Applicant also believes it is inappropriate to rely on Official Notice for multiple elements in the same claim, or even in the same series of claims. In this instance, the reference provided by the Examiner is merely superficial, and the substance of the Examiner's rejection is based solely on Official Notice, which is improper and unsustainable. It appears to Applicant that the Examiner was unable to proffer a proper rejection and instead merely cited a single 98 page reference tangentially related to the present invention and took Official Notice of the majority of the elements of the claims. This is improper and inconsistent with the MPEP, C.F.R., U.S.C., substantive case law, and public policy.

Beyond the fact that Wallace et al. does not teach or suggest that which is claimed, the Examiner failed to provide a convincing line of reasoning as to why the claimed invention is obvious. That is, to establish a *prima facie* case of obviousness, the Examiner must not only show that the reference teaches or suggests each and every element of the claimed invention, but also provide "a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." MPEP §2142 quoting Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). However, the Examiner provided no support for the conclusion that "[d]oing such would provide common knowledge marketing/tracking business acumen with the system of Wallace." Therefore, the Examiner also failed to provide a convincing line of reasoning as to why one of ordinary skill in the art would have found the claimed invention obvious in light of the teachings of the references. MPEP §2142. Therefore, the Examiner failed to establish a *prima facie* case of obviousness.

Applicant believes the claimed invention is patentably distinct from the art of record because Wallace et al. does not teach or suggest each and every element of each and every claim and the Examiner has failed to provide a convincing line of reasoning as to why one of ordinary skill in the art would find that which is claimed obvious in light of the art of record. That is, it is apparent that the Examiner's single paragraph rejection of claims 1-10 as a whole is insufficient to meet the burden required by MPEP §§2142-2143.03 to establish a *prima facie* case of obviousness. Additionally, it should be noted that the Examiner's use of Official Notice is improper, which serves to further illustrate that the instant rejection falls well short of the burden

required to establish a *prima facie* case of obviousness. *Id.* For at least these reasons, the claimed invention is patentably distinct from the art of record.

Therefore, in light of the foregoing, Applicant respectfully believes that the present claims are in condition for allowance. As a result, Applicant respectfully requests timely notice of allowance for claims 1-10 and rejoinder all remaining claims in light of the accompanying Petition for Supervisory Review.

Applicant appreciates the Examiner's consideration of these Remarks and cordially invites the Examiner to call the undersigned, should the Examiner consider any matters unresolved, or believes discussion would further prosecution of this application that has been pending for over three years.

Respectfully submitted,



Timothy J. Ziolkowski
Registration No. 38,368
Direct Dial 262-376-5139
tjz@zpspatents.com

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P.O. ADDRESS:

Ziolkowski Patent Solutions Group, LLC
14135 North Cedarburg Road
Mequon, WI 53097-1416
262-376-5170